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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HANNAHER, CONSTANTINE

ART UNIT

PAPER NUMBER

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MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/718,643	Applicant(s) YASUDA, HIROAKI	
	Examiner Constantine Hannaher	Art Unit 2884	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20090813</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe “an integrated photodetector” such that it might be understood that filters **33, 40** and the detector **32** have any particular structure beyond the label afforded by reference symbol **30**. See page 12, lines 14-16 and FIG. **4C**. The claims are not entitled to a filing date earlier than December 1, 2008. The Examiner notes that this makes Lind *et al.* available under 35 U.S.C. 102(b) and further notes the prohibition of 35 U.S.C. 135(b). Indeed, it would make the publication of the continuation application available under 35 U.S.C. 102(b).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The descriptions of integration in the specification are a combination of the stimulating light projecting system **20** with the photodetector **30** (see page 14, lines 13-16, which in view of the schematic illustrations of FIGs. **1** and **2** conveys nothing more than the elements should, perhaps,

maintain the orientations and distances involved) and the combination of filters with each other or other optical elements. Since there can be no legitimate argument that the excitation and image acquisition station **18** in the disclosure of Mitchell *et al.* (FIG. **5**) fails to integrate the light source **24** and photodetector **58** as required by the specification, the meaning of any structural significance to “an integrated photodetector” which would distinguish the embodiment of FIG. **6A** of Mitchell *et al.* illustrating close proximity of filter **44** and detectors **38** is not apparent.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell *et al.* (US 20030042445A1) in view of one of Struye *et al.* (US006583434B2) and Van de Bergh (US005905014A).

Mitchell *et al.* is available to the examiner under 35 U.S.C. 102(e) even subsequent to the perfection of the claim to foreign priority by the submission of the translation of the priority document on December 7, 2006.

With respect to independent claim 9, Mitchell *et al.* discloses a device (FIG. **6A**) for acquiring latent image information in a phosphor layer (paragraph [0047]) comprising a light source **42** (paragraph [0061]), a detector **38** (paragraph [0083]), and a filter device **44** (paragraph [0084]). The light source, detector, and filter device of Mitchell *et al.* are all for the recited purposes, see paragraph [0062], last two sentences, regarding the transparency and lack of transparency of filter device **44** in

the device of FIG. 6A. The filter device **44** of Mitchell *et al.* is fairly characterized as an absorption filter (paragraph [0062]) and is fairly described as “integrated” with the detector **38** in view of the common fixture (FIG. 2) and the adjacency illustrated (FIG. 6A). Thus, the remaining difference between the scope and content of Mitchell *et al.* and the claim is that Mitchell *et al.* does not identify the construction of “a filter **44**” (paragraph [0084]) as comprising at least two elements. The interchangeability of multiple filters for a single filter is recognized in the art (see column 9, lines 38-65 of Struye *et al.* and column 16, lines 19-35 of Van de Bergh). Because an express suggestion to substitute one known equivalent for another is not required (MPEP § 2144.06) it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the filter device **44** of Mitchell *et al.* such that it comprised at least two absorption filter elements joined to one another.

With respect to dependent claims 10-15 and 18, in view of the “glass filters with multilayer coatings” and “colored glass filters which may also be coated” of Mitchell *et al.* and the extensive knowledge of “filter types and spectral transmittance” available as described by Struye *et al.* and Van de Bergh, the specific transparency and non-transparency of individual filter elements in the filter device **44** of Mitchell *et al.* is a choice within the ordinary skill in the art. Multilayer coatings constitute a reflection layer.

With respect to dependent claims 16 and 19, the transmission of the filter device **44** of Mitchell *et al.* at wavelengths in the first wavelength range is at a degree within the claimed range (paragraph [0062]).

With respect to dependent claims 17 and 20, the transmission of the filter device **44** of Mitchell *et al.* at wavelengths in the second and third wavelength ranges is at a degree within the claimed range (paragraph [0062]).

With respect to independent claim 22, Mitchell *et al.* discloses a device (FIG. 6A) for acquiring latent image information in a phosphor layer (paragraph [0047]) comprising a light source 42 (paragraph [0061]), a detector 38 (paragraph [0083]), and a filter device 44 (paragraph [0084]). The light source, detector, and filter device of Mitchell *et al.* are all for the recited purposes, see paragraph [0062], last two sentences, regarding the transparency and lack of transparency of filter device 44 in the device of FIG. 6A. The filter device 44 of Mitchell *et al.* is fairly characterized as an absorption filter (paragraph [0062]). Thus, the sole difference between the scope and content of Mitchell *et al.* and the claim is that Mitchell *et al.* does not identify the construction of “a filter 44” (paragraph [0084]) as comprising at least two elements. The interchangeability of multiple filters for a single filter is recognized in the art (see column 9, lines 38-65 of Struye *et al.* and column 16, lines 19-35 of Van de Bergh). Because an express suggestion to substitute one known equivalent for another is not required (MPEP § 2144.06) it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the filter device 44 of Mitchell *et al.* such that it comprised at least two absorption filter elements joined to one another.

Response to Submission(s)

7. The amendment filed August 19, 2009 has been entered.
8. Applicant's arguments filed August 19, 2008 have been fully considered but they are not persuasive.

The Examiner notes that Applicant's representative presents one argument for the rejections under separate paragraphs of 35 U.S.C. 112. Since these paragraphs are directed to different aspects of patentability (entitlement to a filing date for the claimed subject matter, scope of the claimed subject matter) the argument does not reply to every ground of rejection and is thus inadequate under 37 CFR 1.111(b).

With respect to the rejection under 35 U.S.C. 112, first paragraph, entitlement to a filing date does not extend to subject matter which is not disclosed, but which would only have been obvious over what is expressly disclosed. One shows that one is “in possession” of *the invention* by describing *the invention*, with all its claimed limitation, not that which makes it obvious. The Examiner has already considered the import of reference symbol **30** in the FIG. **1** that the argument points to and found it inadequate to suggest anything more than a label, see paragraph 4 of the previous action, and the Examiner has also considered the portion of the specification at page 14 and found it inadequate to suggest anything more than maintained orientation and distances, see paragraph 6 of the previous action, so the identification thereof does not show error in the rejection and fails to justify a filing date for the claims earlier than December 1, 2008.

With respect to the rejection under 35 U.S.C. 112, second paragraph, the Examiner has already considered the identified portions of the specification and found them inadequate to suggest anything more than a label, see paragraph 4 of the previous action, or maintained orientation and distances, see paragraph 6 of the previous action, so the identification thereof does not show error in the rejection and fails to justify a finding that the claims particularly point out and distinctly set forth the subject matter of the integrated photodetector. The argument that Mitchell *et al.* discloses an integrated photodetector, while not taken as a concession, is not consistent with the argument that the reference is inadequate to show that claimed feature in an obviousness analysis. Conversely, if Mitchell *et al.* anticipates the claim feature, inclusion of the feature in the claim does not particularly point out and distinctly claim the subject matter which applicant regards as the invention because it is not a technical contribution in which an exclusive property may be obtained.

Applicant has, notwithstanding the inadequacy of the disclosure to support such a recitation, presented no evidence that “integration” of a detector with a filter device is “uniquely challenging or

difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *See, e.g., Leapfrog Enter., Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007). It is not necessary that suggestion or motivation be found within the four corners of the references themselves. “The obviousness analysis cannot be confined by [the] formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of... the explicit content of issued patents.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct 1727, 1741 (2007). An obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take into account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1740-741.

Because after *KSR* those of ordinary skill in the art are allowed to combine prior art elements according to known methods yielding predictable results and are allowed to substitute one known element for another with predictable results and are allowed to pursue known options within his or her technical grasp, it is no longer persuasive to argue that the explicit content of the issued patent lacks a claim feature. But the contention that *Mitchell et al.* does not disclose an integrated photodetector is not warranted on the evidence of FIGs. **1**, **2**, and **6A** therein, which depict an explicitly mechanical “image acquisition station **18**” containing photodetector **38** and filter **44** with more specificity than anything in applicant’s specification (compare the machined and assembled housing of FIG. **1** of *Mitchell et al.* with the *symbolic bracket* labeled **30** by applicant).

The failure to present arguments pointing out the specific distinctions believed to render claim 22 patentable over any applied references is inconsistent with the requirement of 37 CFR 1.114(c). The arguments as applied to claim 22 “fail from the outset because... they are not based on limitations appearing in the claims...,” and are not commensurate with the broader scope of claim

22 which states nothing about an integrated photodetector. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

For at least the reasons explained above, Applicant is not entitled to a favorable determination of patentability in view of the arguments submitted December 1, 2008.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Constantine Hannaher whose telephone number is (571) 272-2437. The examiner can normally be reached on Monday-Friday with flexible hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Constantine Hannaher/
Primary Examiner, Art Unit 2884**